

REMARKS

The Examiner provides a number of rejections and we list them here in the order in which they are addressed:

I. Rejections Under 35 USC § 102(b)

- A. Claims 1, 3, 5 and 6 are rejected as allegedly being anticipated by Raffin *et al.* (US Pat. No. 4,686,100).
- B. Claims 1, 3, 6 and 7 are rejected as allegedly being anticipated by EP 0 245 993

I. The Claims Are Not Anticipated

As the Examiner is well aware, a single reference must disclose each limitation of a claim in order for that reference to anticipate the claim. *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984). This criterion is not met with either the Raffin *et al.* reference or the EP 0 245 993 reference.

The Examiner attempts to make an inherency argument to both of the above cited references. For example,

Absent evidence that immunization with full-length C5a would not generate antibodies to the truncated form, the antibody preparation obtained by the method of the '100 patent would inherently contain antibodies which bind to SEQ ID NO:5. *Office Action*, pg 3 ln 2 - 5.

and,

Absent evidence that immunization with full-length C5a would not generate antibodies to the truncated form, the antibody preparation obtained by the method of the '993 patent would inherently contain antibodies which bind to SEQ ID NO:5. *Office Action*, pg 3 ln 21 - 24.

However, the Examiner has only made conclusory statements and provides no extrinsic evidence to support the conclusion that any antibody generated according to Raffin *et al.* or the '993 reference is directed to the Applicants' SEQ ID NO:5. Contrary to the Examiner's assertion regarding the presentation of evidence as quoted above, patent law clearly places the evidentiary burden of proving inherency on the Examiner.

To establish inherency, the cited reference must have recognized at the time of the Applicants' invention, that the elements now at issue were inherently present in the reference cited by the Examiner. For example, the Federal Circuit held that;

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. *Continental Can USA v. Monsanto Co.*, 212 USPQ 323, 326 (CCPA 1981), *quoting In re Oetrich*, 212 USPQ 323, 326 (CCPA 1981)

and,

[i]n relying upon the theory of inherence, **the examiner must provide** a basis in fact/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. MPEP §2112, *quoting In re Robertson*, 169 F.3d 743 (Fed. Cir. 1999)[underlined emphasis in original, bolded emphasis added).

In the present rejection, the Examiner has not provided: i) any "basis in fact/or technical reasoning" to show that antibodies to Applicants' SEQ ID NO:5 necessarily flows from the teachings of either cited reference (as required by the MPEP); or ii) any extrinsic evidence that the Applicants' SEQ ID NO:5 is necessarily present in the cited references (as required by the Federal Circuit).

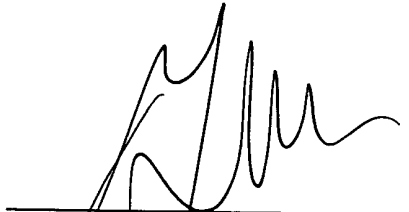
Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claim 1 to recite a closed transition phrase of "consisting of" an antibody specific for SEQ ID NO:5.

Applicants, therefore, respectfully request the Examiner to withdraw the anticipation rejections based upon *Raffin et al.* and EP 0 245 993 and allow the pending claims.

CONCLUSION

The Applicants believe that the arguments and claim amendments set forth above traverse the Examiner's rejections and, therefore, request that all grounds for rejection be withdrawn for the reasons set above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 617.984.0616.

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